

### REMARKS

The specification has been amended in accordance with the objections and rejections noted in the Action.

Claims 1-3 have been amended. Claims 4-5 have been canceled without prejudice or disclaimer, and this cancellation renders the drawing rejection under 37 C.F.R. § 1.83 (a) and the claim 5 rejection under 35 U.S.C. § 112 moot. Amendments to the specification and claims have been done without the addition of any new matter as support may be found in relevant portions of the specification and drawings (e.g., FIGs. 1-3).

Reconsideration of the application is respectfully requested.

1. Rejection of Claims 1-4, and 7 under 35 U.S.C. § 102(a) as being unpatentable over U.S. Patent 6,507,336 (Lunsford)

Claims 1-4, and 7 stand rejected as being unpatentable over Lunsford. For the reasons discussed below, Applicants respectfully traverse this rejection by asserting that Lunsford fails to disclose, suggest, or teach at least one element of claim 1. Further, Claims 2-3, and 7, which depend from claim 1, are also patentable based on their dependency and their individually recited elements.

- a. Invention Distinguished

Claim 1, as amended, recites a portable computer having a hidden keyboard structure including a shell having a top face, and four peripheral sides, the shell having installed in said top face thereof an LCD panel and an alphanumeric keyboard.

b. References Distinguished

Lunsford discloses a single-cover and dual-cover encasement 200, 300, coupled to a handheld computer using a spine 202, 306, where the inside cover 208, 310 of the encasement includes a stylus-tappable keyboard 236, 340 (see FIGs. 2-3; col. 6, lines 15-24; 61-67; col. 7, lines 31-40, 66-67; col. 8, lines 1-6). The Action expressly admits that Lunsford fails to disclose the recited feature of a top face including an LCD panel and an alphanumeric keyboard, since Lunsford solely discloses that the keyboard is on the inside cover of the encasement, making the claimed invention patentably distinct and non-obvious from the cited reference.

c. Anticipated Obviousness Rejection

Further, in anticipation of an obviousness rejection being used against amended Claim 1 by combining Lunsford and Rosch (similar to the current rejection asserted against claim 6), the following is provided to traverse this anticipated rejection.

Combination of Lunsford and Rosch is Improper, and also Distinguished

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the rejection must identify some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the cited references. *MPEP* §§ 706.02(j), 2142. When the motivation to combine the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the references is proper. *MPEP* § 2142. Additionally, the mere fact that references can be combined does not support a proper obviousness rejection unless the desirability of the combination is also suggested in the prior art. *Id.* And further, the proposed modification or combination of the prior art references cannot render the prior art unsatisfactory for its intended purpose. *MPEP* 2143.01.

These requirements are not met by an obviousness rejection of claims 1-4, and 7 as the combination of the Lunsford and Rosch references is improper since there lacks any suggestion or motivation to combine these references. Firstly, Lunsford solely describes incorporating a stylus-tappable keyboard into the inside face of either a single or dual-cover encasement which a handheld computer may be coupled thereto (see FIGs. 2-3; col. 6, lines 15-24; 61-67; col. 7, lines 31-40, 66-67; col. 8, lines 1-6). Particularly, Lunsford's keyboard apparatus is solely directed to a very much smaller than conventional size keyboard (e.g., 5" X 3" as opposed to 18" X 7") to allow easy access by a stylus which is especially useful to handicapped users (see col. 3, lines 28-67; col. 4, lines 1-16). Thus, Lunsford solely describes a very small keyboard that is particularly located on the inside cover of a handheld computer encasement.

In contrast, the Rosch disclosure describes a pointing device (e.g., TouchPad) for a notebook computer that just happens to show a picture of a notebook computer including its standard-size keyboard (see Figure). Therefore, to combine Lunsford and Rosch, somehow a standard-size keyboard with a size of 18" X 7" must fit onto the face of a handheld computer to occupy the size of 5" X 3" which is a near impossibility. Further, Rosch's standard-size keyboard is to be used by human fingers in strong contrast to Lunsford's keyboard which is very much smaller and directed to be used by a stylus. Also, Lunsford already teaches putting the keyboard on the encasement and therefore incorporating Rosch to put the keyboard on the face of the handheld computer would be completely redundant, and would take away the purpose of Lunsford's encasement which is to hold and protect the keyboard by placing it on the inside surface of the encasement cover.

Also, the combination is improper and still would not include all the features of the recited invention since the conventional notebook computer as shown by Rosch includes a top face which is wholly taken up by the display panel, and a separate bottom face which includes the conventional keyboard and pointing device. Therefore, any combination of Lunsford and Rosch would still suggest having the display (LCD)

panel on a separate face from the keyboard which is significantly distinct from a top face including both an LCD panel and an alphanumeric keyboard as recited.

Based on the above observations, it is respectfully requested that the obviousness rejection be withdrawn as there lacks any suggestion in the references for proper combination of the references and still omits at least one recited element, therefore failing to make a *prima facie* case of obviousness.

Accordingly, Applicants submit that Lunsford or Rosch, either alone or in combination, do not disclose, suggest or teach the claimed invention of claims 1-3, and 6-7. Withdrawal of the rejection is respectfully requested.

2. Rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Lunsford and Winn L. Rosch Hardware Bible (Rosch)

Claim 6 stands rejected as being unpatentable over Lunsford and Rosch. For the reasons discussed above, Applicants respectfully traverse this rejection by asserting that the combination of Lunsford and Rosch is improper, and further that Lunsford and Rosch, either alone or in combination, fail to disclose, suggest, or teach at least one element of claim 6. Withdrawal of the rejection is respectfully requested.

3. Conclusion

In view of the amended claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-3, and 6-7 be allowed and the application be passed to issue.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayments to Deposit Account No. 02-

U. S. Application No. 10/622,696  
Group Art Unit 2835  
Examiner: Zachary Pape


0200 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

The Examiner is invited to contact the undersigned at (703) 683-0500 to discuss the application.

BACON & THOMAS, PLLC  
625 Slaters Lane, 4<sup>th</sup> Floor  
Alexandria, VA 22314-1176  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080  
Date: January 27, 2005

01-25-05 amendment.wpd

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

JUSTIN J. CASSELL  
Attorney for Applicant  
Registration No. 46,205